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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

PHAN, H

ART UNIT

PAPER NUMBER

3619

DATE MAILED:

09/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/145,381	Applicant(s) SAUTER, TOM	
	Examiner Hau V Phan	Art Unit 3619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-21, 24-27 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20, 21, 24-27 and 29-34 is/are allowed.
- 6) ☒ Claim(s) 1-9, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 10-13, 16-19 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

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DETAILED ACTION

Claim Objected

1. Claim 29 is objected to because of the following informalities: Claim 29 depends on claim 28, which had been canceled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Benoit.

Benoit in figures 1-15 disclose a skate frame (2) for an inline skate comprising an elongate first structural member having first and second sidewalls (2E, see figure 3) depending downwardly from a first upper surface (4). The lower ends of the sidewalls being spaced to receive wheels therebetween, and flexible vibration dampening means (8E) integrally formed with the sidewalls of the first structural member for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface.

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Regarding Claim 6, Benoit discloses a second structural member (C, see attached figure 4) having first and second sidewalls (2F) held in parallel disposition by a second upper wall (D). The second structural member has an open lower end sized (6) to receive the wheels therebetween. The second structural member also has a width (E) sized to be received within the first structural member such that the sidewalls of the first structural member (A) overlap at least a portion of the sidewalls of the second structural member (see Fig 4).

4. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Benoit.

Benoit in figures 1-15 discloses a skate frame comprising:

- a) an elongate first structural member (A, see attached figure 4) having downwardly depending first and second sidewalls (B). The lower ends of the sidewalls being spaced to receive wheels therebetween;
- b) an elongate second structural member (C) having downwardly depending first and second sidewalls (2F). The sidewalls of the second structural member being spaced to receive the first and second structural member there between, such that the sidewalls of the second structural member overlap at least a portion of the sidewalls of the first structural member;
- c) and vibration dampening member (8F) integrally formed with the sidewalls of the first and second structural members for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

LM 6. Claims 2-3, ⁴5, 7-9, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit as applied to claims 1, 14 above, and further in view of Malewicz.

Benoit discloses a vibration dampening means and a skate frame, but fails to show the vibration dampening means comprises a contoured portion and the skate frame in arcuate shaped.

Regarding claim 2, Malewicz further discloses that the vibration dampening means comprises a contoured portion (130, 160) of each of the first (32) and second (34) sidewalls of the first structured member (14). The contoured portion (160) has a predetermined cross-sectional shape to permit the sidewalls to flex (impliedly disclosed at col 6, lines 1-15; Malewicz discloses a flexible, lightweight fiberglass polyamide frame) thereby absorbing at least a portion of the vibrational energy associated with traversing the surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate frame of Benoit with the contour portion as taught by Malewicz in order to have more flexibility on the vibration dampening means.

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Regarding Claim 3, Malewicz further discloses that the cross-sectional shape of the first and second sidewalls is substantially arcuate (see fig 6) such that the contoured portion of the sidewalls flexes to absorb at least a portion of the vibrational energy.

Regarding claim 4, Malewicz further discloses that the arcuate cross-sectional shape of the first and second sidewalls is substantially C-Shaped in configuration (see fig 2), the arcuate cross-sectional shape having an upper end (200) spaced from a lower end (110) by a concave portion (136).

Regarding claim 5, Malewicz further discloses that the concave portion (136) of the first sidewall (32) faces the concave portion (166) of the second sidewall (34) in an opposed manner such that the first structural member (12) is tubular.

Regarding claim 7, Malewicz further discloses that the vibration dampening means comprises a contoured portion (170) of each of the first and second sidewalls (32, 34) of the first structural member, the contoured portion having a predetermined cross sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the vibrational energy associated with traversing the surface.

Regarding claim 8, Malewicz further discloses that the cross-sectional shape of the sidewalls of the first (32) and second (34) structural members are substantially arcuate (see Fig 2), such that the arcuate cross-sectional shape of the sidewalls flexes to absorb at least a portion of the vibrational energy (Col 3, line 65- Col 4, line 10), wherein the arcuate cross-sectional shape of the first and second sidewalls is

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substantially C-shaped in configuration, the arcuate cross-sectional shape of each sidewall has an upper end spaced from a lower end by a concave portion.

Regarding claim 9, Malewicz further discloses that the concave portion (136) of the first sidewall (32) of the first (upper, curved 32) and second (110) structural members faces the concave portion of the second sidewall of the first (118) and second (upper, curved 34) structural members in an opposed manner. See Fig 2.

Regarding claim 15, Malewicz further discloses that the vibration dampening member comprises contouring the sidewalls of both the first and second structural members to a predetermined cross-sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the vibrational energy associated with traversing the surface. Col 6, lines 1-15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate frame of Benoit with the substitution of skate frame as taught by Malewicz in order to have more flexibility on the skate frame.

Allowable Subject Matter

7. Claims 20-21, 24-27, 29-34 are allowed.

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8. Claims 10-13, 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to claims 1-9, 14-15, 20-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau V Phan whose telephone number is 703-308-2084. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2571 for regular communications and 703-308-2571 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

HP *HP*

September 19, 2001

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 8

Lanna Mai